

REMARKS

In response to the Office Action mailed January 18, 2007, Applicants respectfully request reconsideration.

To further the prosecution of this application, each of the rejections presented in the Office Action is responded to below. No amendments have been made. The claims as presented are believed to be in condition for allowance.

I. Summary of Telephone Conference with Examiner Hageman and Supplemental Remarks

On April 11, 2007, Applicants' representative, Melissa A. Beede, spoke with the Examiner by telephone to discuss the rejections of the outstanding Office Action. The discussion is summarized below. Applicants appreciate the courtesies extended by the Examiner in agreeing to discuss the rejections of the Office Action.

Applicants' representative summarized the basis for the lack of a suggestion or motivation to combine the reference teachings presented in sections II-IV below (which were included in the draft response submitted to the Examiner, a copy of which is attached hereto). The Examiner indicated that he had reviewed Applicants' arguments and that it would be helpful for the Applicants to expound on the lack of desirability for proposed modification of the mail case of the Pippin reference (i.e., by considering Pippin as the primary reference being modified rather than as the secondary reference as indicated in the Office Action). Accordingly, Applicants supplement the remarks in sections II-IV below with the following remarks:

U.S. Patent No. 6,715,614 ("Pippin") teaches a mail case in which mail is sorted into individual bags, each representing a unique delivery point (e.g., col. 2, lines 23-25). The mail case is described as overcoming "significant problems" with traditional mail cases (col. 1, line 47). The problems described are that "dividers 21 between stops in existing USPS mail cases are relatively rigid, and they cannot be conveniently repositioned during a sort" (col. 1, lines 47-50). Each of U.S. Patent No. 1,659,509 ("Ashbrook"), U.S. Patent No. 3,908,821 ("Lambert") and U.S. Patent No. 3,754,646 ("Henig") is directed to some form of sorter having relatively rigid dividers that

cannot be conveniently repositioned during a sort. *Accordingly, one would not have been motivated to combine Ashbrook, Lambert or Henig with Pippin, because Pippin teaches away from the use of rigid dividers that cannot be conveniently repositioned during a sort.*

Indeed, Pippin states that “*an essential principle of the invention is the use of slot dividing walls made of flexible or compliant material which permits random overfilling of certain slots while maintaining the same overall slot density*” (col. 4, lines 1-5, emphasis added). Modifying Pippin in the manner suggested would render the mail case of Pippin unable to perform its essential purpose, and would therefore render the mail bin unsatisfactory for its intended purpose. As set forth in MPEP §2143.01, *a proposed modification cannot render the prior art invention being modified unsatisfactory for its intended purpose.*

Further, there is clearly no suggestion of the *desirability* of modifying the mail case of Pippin in the manner suggested (on the contrary, the modification appears quite undesirable). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (see MPEP §2143.01).

Finally, Applicants note that the teaching or suggestion to make a claimed combination must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (see MPEP §2142). The Examiner has not cited any portion of the references themselves for the motivation for the combinations (see, e.g., Office Action at pages 3 and 5); thus, the motivation appears to be drawn from alleged knowledge in the art, or “well-known” prior art pursuant to MPEP §2144.03. Applicants respectfully traverse the assertion that there is any well-known prior art that would have motivated one of ordinary skill in the art to modify the combined teachings of the references in the manner suggested for the reasons explained above. If the rejection is to be maintained, the Examiner is therefore respectfully requested to cite a reference in support of his position as required in MPEP §2144.03, or if the Examiner is relying upon facts within the Examiner's personal knowledge, to file an affidavit establishing those facts pursuant to §2144.03.

For the foregoing reasons, Applicants submit that there is no suggestion or motivation to modify the mail case of Pippin based on the teachings of Ashbrook, Lambert or Henig.

II. Rejections Under 35 U.S.C. §103 – Ashbrook in view of Pippin

Claims 1, 2, 4-10 and 12-27 (including independent claims 1, 9, 19 and 20) were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 1,659,509 (“Ashbrook”) in view of U.S. Patent No. 6,715,614 (“Pippin”). These rejections are respectfully traversed.

a. Independent claim 1

The Office Action concedes that Ashbrook does not disclose a mail sorting bin insert “wherein each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin,” as recited in claim 1. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Ashbrook to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin and dimensioning the insert such that it fits closely within letter trays used by the USPS, as taught by Pippin, for the purposes of maintaining sequence order and facilitating delivery and allowing storage and use of the insert with flats tubs or letter trays.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated for the reasons set forth below.

First, the flats tub or letter tray 50 of Pippin is *completely unrelated in structure and function* to the envelope holder of Ashbrook. In particular, the flats tub or letter tray 50 is used by the U.S. Postal Service (e.g., for mail delivery), while the envelope holder of Ashbrook is used by individuals to hold envelopes with a desk drawer (Pippin at col. 6, lines 9-15; Ashbrook at col. 2, lines 62-66). As a result, there is simply no motivation to dispose the envelope holder of Ashbrook within the flats tub or letter tray 50 of Pippin. Doing so would produce no apparent desirable effect.

In fact, not only is there no suggestion of the desirability of placing the envelope holder of Ashbrook in the flats tub or letter tray 50 of Pippin, but doing so would clearly be *undesirable*. Ashbrook discloses an envelope holder having a principle use “to hold envelopes... within a desk drawer” (col. 2, lines 62-64). Placing the envelope holder of Ashbrook in the flats tub or letter tray 50 of Pippin would prevent the envelope holder from being disposed within a desk drawer, thereby thwarting its principle use. Further, replacing the multi-bag storage device 30 of Pippin with the

envelope holder of Ashbrook would also be undesirable. Such a modification would prohibit the intended use of the Pippin device, i.e., “sequence-sorting various types of mail together into individual bags that each represent unique delivery points” (col. 2, lines 22-24). It is well established that the prior art must suggest the desirability of the modification (see e.g., MPEP § 2143.01). Thus, the proposed combination of Ashbrook and Pippin is improper.

Second, there is absolutely no suggestion or motivation to modify the envelope holder of Ashbrook such that each “support” of the envelope holder is “constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin” (i.e., the flats tub or letter tray 50 of Pippin), as suggested in the Office Action. Doing so would again be an undesirable modification of the envelope holder of Ashbrook. The envelope holder is constructed to hold envelopes “in such positions that any of them may be readily be grasped and removed” (col. 1, lines 1-6). If the “supports” of the envelope holder were made significantly greater than the heights of the envelopes, as suggested by the proposed modification, the envelopes could not be readily grasped and removed, making the envelope holder unsatisfactory for its intended purpose. Further, there is no suggestion of the desirability of replacing the multi-bag storage device 30 of Pippin with the envelope holder of Ashbrook. As stated previously, the envelope holder would not be usable for “sequence-sorting various types of mail together into individual bags that each represent unique delivery points,” the objective of the Pippin device, even if there was some motivation to modify the envelope holder in all of the aspects set forth in the Office Action (and Applicants respectfully submit that there is not).

Third, there is no motivation to dimension the envelope holder of Ashbrook such that at least one of the length and the width substantially corresponds to at least one of a length and width of the flats tub or letter tray 50 of Pippin. Indeed, dimensioning the envelope holder of Ashbrook such that at least one of the length and the width substantially corresponds to at least one of a length and width of the flats tub or letter tray 50 of Pippin would be *undesirable*. Dimensioning the envelope holder in this way would make it difficult or impossible to dispose the envelope holder in conventional desk drawers. Further, dimensioning the envelope holder of Ashbrook such that at least one of the length and the width substantially corresponds to at least one of a length and width of the flats tub or letter tray 50 of Pippin would not make the envelope holder usable for sequence-

sorting various types of mail together into individual bags (the objective of the Pippin device), or any other obvious purpose.

Fourth, Applicants note that the modifications to the envelope holder of Ashbrook suggested in the Office Action represent a *substantial reconstruction and redesign* of the envelope holder, resulting in a *change of its very purpose*. As set forth in MPEP § 2143.01, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In view of the foregoing, there is no motivation for the combination of Ashbrook and Pippin proposed in connection with the rejection of claim 1. Accordingly, withdrawal of this rejection of claim 1 is respectfully requested.

b. Independent Claim 9

The Office Action concedes that Ashbrook does not disclose a mail sorting bin insert “wherein each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin,” as recited in claim 9. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Ashbrook to include each substantially vertical section has [*sic*] a height of approximately 11 inches when the insert is disposed within the mail sorting bin, as taught by Pippin, for the purpose of storing and using the insert with flats tubs or letter trays.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated for the reasons set forth below.

First, for the reasons discussed in connection with claim 1, there is simply no motivation to dispose the envelope holder of Ashbrook within the flats tub or letter tray 50 of Pippin.

Second, even if a person were for some reason motivated to dispose the envelope holder of Ashbrook within the flats tub or letter tray 50 of Pippin, there would still be no motivation to construct the dividers thereof to have a height of approximately 11 inches. Doing so would again be an undesirable modification of the envelope holder of Ashbrook. As discussed herein, the envelope holder is constructed to hold envelopes “in such positions that any of them may be readily be

grasped and removed” (col. 1, lines 1-6). If the “supports” of the envelope holder were made significantly greater than the heights of the envelopes, as suggested by the proposed modification, the envelopes could not be readily grasped and removed, making the envelope holder unsatisfactory for its intended purpose. Further, there is no suggestion of the desirability of replacing the multi-bag storage device 30 of Pippin with the envelope holder of Ashbrook.

In view of the foregoing, there is no motivation for the combination of Ashbrook and Pippin proposed in connection with the rejection of claim 9. Accordingly, withdrawal of this rejection of claim 9 is respectfully requested.

c. Independent Claim 19

There is no motivation for the combination of Ashbrook and Pippin proposed in connection with the rejection of claim 19.

First, for the reasons discussed in connection with claim 1, there is no suggestion or motivation to modify the envelope holder of Ashbrook such that each “support” of the envelope holder is “constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin.”

Second, there is no suggestion to modify the envelope holder of Ashbrook such that the base is sized to substantially cover a bottom surface of the flats tub or letter tray 50 of Pippin. Indeed, modifying the envelope holder of Ashbrook such that the base is sized to substantially cover a bottom surface of the flats tub or letter tray 50 of Pippin would be *undesirable*. Modifying the envelope holder in this way would make it difficult or impossible to dispose the envelope holder in conventional desk drawers, a stated objective of the envelope holder. Further, the modification would not make the envelope holder usable for sequence-sorting various types of mail together into individual bags, a stated objective of the Pippin device, or for any other obvious purpose.

In view of the foregoing, there is no motivation for the combination of Ashbrook and Pippin proposed in connection with the rejection of claim 19. Accordingly, withdrawal of this rejection of claim 19 is respectfully requested.

d. Independent Claim 20

There is no motivation for the combination of Ashbrook and Pippin proposed in connection with the rejection of claim 20. In particular, for reasons similar to those discussed in connection with claim 9, there is no motivation to construct each “support” of the envelope holder of Ashbrook to have a height of approximately 11 inches.

Further, Ashbrook does not teach or suggest “a flat sheet, wherein the flat sheet includes a plurality of sections and a plurality of predefined fold lines,” as recited in claim 20. Rather, Ashbrook discloses a sheet metal material including bends that form pockets.

In view of the foregoing, there is no motivation for the combination of Ashbrook and Pippin proposed in connection with the rejection of claim 20, and the combination nevertheless does not disclose each of the features of claim 20. Accordingly, withdrawal of this rejection of claim 20 is respectfully requested.

III. Rejections Under 35 U.S.C. §103 - Lambert in view of Pippin

Claims 1-13 and 15-27 (including independent claims 1, 9, 19 and 20) were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 3,908,821 (“Lambert”) in view of U.S. Patent No. 6,715,614 (“Pippin”). These rejections are respectfully traversed.

a. Independent claim 1

The Office Action concedes that Lambert does not disclose a mail sorting bin insert “wherein each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin,” as recited in claim 1. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Lambert to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin, as taught by Pippin, for the purposes of maintaining sequence order and facilitating delivery.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated.

First, the record keeping tray 10 of Lambert is not used for storing or delivering flat mail. Rather, the record keeping tray 10 is used for filing cancelled checks (Abstract). Thus, a person of ordinary skill in the art would not have been motivated to modify Lambert to construct the dividers 13 such that a maximum height of each divider 13 approximates a maximum height of the record keeping tray 10 for the purpose of “facilitating delivery,” as suggested in the Office Action, because the record keeping tray is not used for mail delivery. Moreover, a person of ordinary skill in the art would not have been motivated to modify Lambert in this manner for the purpose of “maintaining sequence order,” as suggested in the Office Action. Making the dividers 13 taller would clearly have no effect on whether the cancelled checks were maintained in an orderly fashion. The dividers 13 are sufficiently tall to support the pockets 14, which hold the cancelled checks, and no apparent benefit would be derived from increasing the height of the dividers 13.

Second, Applicants note that the modifications to the record keeping tray 10 of Lambert suggested in the Office Action represent a *substantial reconstruction and redesign* of the record keeping tray, resulting in a *change of its very purpose*. As set forth in MPEP § 2143.01, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Further, the record keeping tray 10 is not a “mail sorting bin,” as recited in claim 1. The tray is used to store cancelled checks and other financial records, and not for sorting mail.

In view of the foregoing, there is no motivation for the combination of Lambert and Pippin proposed in connection with the rejection of claim 1, and the combination nevertheless does not disclose each of the features of claim 1. Accordingly, withdrawal of this rejection of claim 1 is respectfully requested.

b. Independent Claim 9

The Office Action concedes that Lambert does not disclose a mail sorting bin insert “wherein each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin,” as recited in claim 9. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Lambert to include each substantially vertical section has [*sic*] a height of approximately 11 inches when the insert is disposed within the mail sorting bin, as taught by Pippin, for the purpose of storing and using the insert with flats tubs or letter trays.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated. The record keeping tray 10 of Lambert is not used for storing or delivering flat mail. Rather, the record keeping tray 10 is used for filing cancelled checks (Abstract). Thus, there is absolutely nothing in the references or generally known knowledge that would have been motivated a person of ordinary skill in the art to modify Lambert to construct the dividers 13 to have a height of approximately 11 inches "for the purpose of storing and using the insert with flats tubs or letter trays," as suggested in the Office Action. It would simply not be logical to use the record keeping tray 10 with a flats tub or letter tray.

Moreover, modifying the dividers 13 to have a height of approximately 11 inches would serve no apparent beneficial purpose, and would actually be undesirable. The dividers 13 are sufficiently tall to support the pockets 14, which hold the cancelled checks, and no apparent benefit would be derived from increasing their height. Further, constructing each divider 13 to have a height of approximately 11 inches would be an undesirable, because the cover 11 of the record keeping tray 10 would not be closable if the dividers 13 each had a height of approximately 11 inches.

Further, the record keeping tray 10 is not a "mail sorting bin," as recited in claim 9. The tray is used to store cancelled checks and other financial records, and not for sorting mail.

In view of the foregoing, there is no motivation for the combination of Lambert and Pippin proposed in connection with the rejection of claim 9, and the combination nevertheless does not disclose each of the features of claim 9. Accordingly, withdrawal of this rejection of claim 1 is respectfully requested.

c. Independent Claim 19

There is no motivation for the combination of Lambert and Pippin proposed in connection with the rejection of claim 19.

First, for the reasons discussed in connection with claim 1, there is no suggestion or motivation to modify the envelope holder of Lambert such that each divider 13 of the record keeping tray 10 is “constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin.”

Second, there is no suggestion to modify the record keeping tray 10 of Lambert such that the base is sized to substantially cover a bottom surface of the flats tub or letter tray 50 of Pippin. Indeed, modifying the record keeping tray 10 of Lambert such that the base is sized to substantially cover a bottom surface of the flats tub or letter tray 50 of Pippin would be *undesirable*. Modifying the envelope holder in this way would make it completely oversized, and therefore unnecessarily unwieldy, for its purpose of storing cancelled checks. Further, the proposed modification would not make the record keeping tray 10 of Lambert usable for sequence-sorting various types of mail together into individual bags, the purpose of the Pippin device.

In view of the foregoing, there is no motivation for the combination of Lambert and Pippin proposed in connection with the rejection of claim 19. Accordingly, withdrawal of this rejection of claim 19 is respectfully requested.

d. Independent Claim 20

There is no motivation for the combination of Lambert and Pippin proposed in connection with the rejection of claim 20.

For reasons similar to those discussed in connection with claim 9, there is no motivation to construct each divider 13 of the record keeping tray 10 of Lambert to have a height of approximately 11 inches.

In view of the foregoing, there is no motivation for the combination of Lambert and Pippin proposed in connection with the rejection of claim 20. Accordingly, withdrawal of this rejection of claim 20 is respectfully requested.

IV. Rejections Under 35 U.S.C. §103 - Henig in view of Pippin

Claims 1-13 and 15-27 (including independent claims 1, 9, 19 and 20) were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 3,754,646 ("Henig") in view of U.S. Patent No. 6,715,614 ("Pippin"). These rejections are respectfully traversed.

a. Independent claim 1

The Office Action concedes that Henig does not disclose a mail sorting bin insert "wherein each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin," as recited in claim 1. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Henig to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin, as taught by Pippin, for the purposes of maintaining sequence order and facilitating delivery.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated for the reasons set forth below.

First, the receptacle 1 of Henig is used for an entirely different purpose than the multi-bag storage device 30 of Pippin. In particular, the multi-bag storage device 30 of Pippin is used for "sequence-sorting various types of mail together into individual bags that each represent unique delivery points" (col. 2, lines 22-24). The receptacle 1 of Henig is used to receive and arrange letters of a single group dropped therein and not to sort mail into separate groups. Each notch 7 of the receptacle 1 is used to hold a *single letter* and the receptacle 1 as a whole is used to hold letters of one group (e.g., an address) (col. 6, lines 1-11, col. 2, lines 23-27 and col. 4, lines 40-51). There is absolutely nothing in the references or generally known knowledge that would have been motivated a person of ordinary skill in the art to modify Henig to construct the notches 7 such that a maximum height of each notch 7 approximates a maximum height of the receptacle. Doing so would serve no apparent beneficial purpose, and would certainly not be a desirable modification. Although the Office Action suggests a motivation of "maintaining sequence order and facilitating delivery," the letters of Henig are not intended to be in sequence order or separately delivered.

Moreover, replacing the individual bags of Pippin with the bottom wall 2 of Henig would undesirably destroy the ability of the Pippin device to sequence-sort various types of mail together into individual bags.

Second, Applicants note that the modifications to the receptacle 1 of Henig suggested in the Office Action represent a *substantial reconstruction and redesign* of the receptacle, resulting in a *change of its very purpose*. As set forth in MPEP § 2143.01, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In view of the foregoing, there is no motivation for the combination of Henig and Pippin proposed in connection with the rejection of claim 1. Accordingly, withdrawal of this rejection of claim 1 is respectfully requested.

b. Independent Claim 9

The Office Action concedes that Henig does not disclose a mail sorting bin insert “wherein each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin,” as recited in claim 9. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Henig to include each substantially vertical section has [*sic*] a height of approximately 11 inches when the insert is disposed within the mail sorting bin, as taught by Pippin, for the purpose of storing and using the insert with flats tubs or letter trays.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated for the reasons set forth below.

First, the flats tub or letter tray 50 of Pippin is *completely unrelated in structure and function* to the receptacle 1 of Henig. As a result, there is simply no motivation to dispose the receptacle 1 of Henig within the flats tub or letter tray 50 of Pippin. Doing so would produce no apparent desirable effect. In fact, the Pippin device would actually be compromised, because it would no longer be able to serve its intended purpose of sequence-sorting various types of mail together into individual bags.

Second, even if a person were for some reason motivated to dispose the receptacle 1 of Henig within the flats tub or letter tray 50 of Pippin, there would still be no motivation to construct each notch 7 to have a height of approximately 11 inches. Doing so would make it extremely difficult to remove each letter from its corresponding notch (indeed, a special tool would likely be required), and would serve no apparent beneficial purpose. For at least this reason, there is no motivation to construct each notch 7 to have a height of approximately 11 inches based on the teachings of Pippin.

In view of the foregoing, there is no motivation for the combination of Henig and Pippin proposed in connection with the rejection of claim 9. Accordingly, withdrawal of this rejection of claim 9 is respectfully requested.

c. Independent Claim 19

There is no motivation for the combination of Henig and Pippin proposed in connection with the rejection of claim 19.

First, for the reasons discussed in connection with claim 1, there is no suggestion or motivation to modify the envelope holder of Henig such that each notch 7 of the receptacle 1 is “constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin.”

Second, there is no suggestion to modify the receptacle 1 of Henig such that the base is sized to substantially cover a bottom surface of the flats tub or letter tray 50 of Pippin. The proposed modification would compromise the Pippin device by destroying its ability to sequence-sorting various types of mail together into individual bags.

In view of the foregoing, there is no motivation for the combination of Henig and Pippin proposed in connection with the rejection of claim 19. Accordingly, withdrawal of this rejection of claim 19 is respectfully requested.

d. Independent Claim 20

There is no motivation for the combination of Henig and Pippin proposed in connection with the rejection of claim 20.

For reasons similar to those discussed in connection with claim 9, there is no motivation to construct each notch 7 of the receptacle 1 of Henig to have a height of approximately 11 inches.

In view of the foregoing, there is no motivation for the combination of Henig and Pippin proposed in connection with the rejection of claim 20. Accordingly, withdrawal of this rejection of claim 20 is respectfully requested.

V. Dependent Claims

Claims 2-8, 22 and 24 depend from independent claim 1; claims 10-13, 15-18 and 25 depend from independent claim 9, claims 23 and 26 depend from independent claim 19; and claims 21 and 27 depend from independent claim 20.

Since each of these dependent claims depends from a base claim that is believed to be in condition for allowance, Applicants believe that it is unnecessary at this time to argue the allowability of each of the dependent claims individually. However, Applicants do not necessarily concur with the interpretation of the dependent claims as set forth in the Office Action, nor do Applicants concur that the basis for the rejection of any of the dependent claims is proper. Therefore, Applicants reserve the right to specifically address the patentability of the dependent claims in the future, if deemed necessary.

CONCLUSION

In view of the foregoing, Applicants believe the pending application is in condition for allowance. A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

April 18, 2007

Enclosure

By: Melissa Beede
Melissa A. Beede
Registration No.: 54,986
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*** TX REPORT ***

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TIME USE 05'46
PAGES SENT 19
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F A X C O V E R

*****OFFICIAL FAX*****

Date: March 30, 2007 **Number of pages (Including cover):** 19

To: Examiner Mark Hageman, Group Art Unit 3653, U.S. Patent and Trademark Office

Fax No.: (571) 273-3027

Serial No.: 10/718,362

Title: **FLAT MAIL VERTICAL STACKING AID**

From: Melissa A. Beede

Direct dial: 617.646.8287

Our File #: L0562.70048US00

MESSAGE:

Examiner Hageman,

Thank you for your phone message of March 29, 2007. Attached is a draft response to the outstanding Office Action.

Best regards,
Melissa

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	10/718,362-Conf. #9518
Filing Date	November 20, 2003
First Named Inventor	Michael E. Caporali
Art Unit	3653
Examiner Name	M. Hageman
Attorney Docket Number	L0562.70048US00
Total Number of Pages in This Submission	22

ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Response to Non-Final Office Action	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	Amendment Transmittal Return Receipt Postcard
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	Copy of DRAFT RESPONSE faxed to Examiner on 3/30/2007
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Landscape Table on CD	
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	WOLF, GREENFIELD & SACKS, P.C.		
Signature			
Printed name	Melissa A. Beede		
Date	April 18, 2007	Reg. No.	54,986

Certificate of Mailing Under 37 CFR 1.8(a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: 4/18/07

Signature: (Janet D'Annunzio-Ellis)



DRAFT RESPONSE FOR DISCUSSION PURPOSES

Docket No.: L0562.70048US00
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael E. Caporali
Serial No.: 10/718,362
Confirmation No.: 9518
Filed: November 20, 2003
For: FLAT MAIL VERTICAL STACKING AID
Examiner: Mark Hageman
Art Unit: 3653

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DRAFT RESPONSE TO NON-FINAL OFFICE ACTION

FOR DISCUSSION PURPOSES ONLY

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action mailed January 18, 2007, Applicants respectfully request reconsideration:

A Listing of the Pending Claims begins on page 2 of this response.

Remarks begin on page 6 of this response.

Listing of the Pending Claims

1. (Previously Presented) A mail sorting bin insert, constructed to be disposed within a mail sorting bin, the insert comprising:
a bottom defining a substantially planar surface having a length and a width, wherein at least one of the length and the width substantially corresponds to at least one of a length and width of the mail sorting bin; and
at least one support projecting upright from the bottom, wherein the support is sized and configured to support flat mail in a substantially vertical orientation, and wherein each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin.
2. (Original) The mail sorting bin insert of Claim 1, wherein the insert comprises a lightweight material.
3. (Original) The mail sorting bin insert of Claim 2, wherein the insert comprises a material selected from the group consisting of cardboard, plastic, wood, and composites.
4. (Original) The mail sorting bin insert of Claim 1, wherein the insert comprises two supports.
5. (Previously Presented) The mail sorting bin insert of Claim 4, wherein the bottom of the insert comprises three substantially coplanar sections which are separated from each other by the two supports, and wherein the two supports have substantially triangular-shaped cross sections.
6. (Original) The mail sorting bin insert of Claim 1, wherein the at least one support has a triangular-shaped cross section.
7. (Original) The mail sorting bin insert of Claim 1, wherein the bottom and at least one support are created from a single piece of material.

8. (Original) The mail sorting bin insert of Claim 7, wherein the at least one support is created by folding the single piece of material.
9. (Previously Presented) A mail sorting bin insert, constructed to be disposed within a mail sorting bin, the insert comprising at least one substantially rigid substantially vertical section projecting from a substantially horizontal section, wherein the insert is sized and configured to receive flat mail from an automatic mail sorter, and wherein each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin.
10. (Original) The mail sorting bin insert of claim 9, wherein the insert comprises a lightweight material.
11. (Original) The mail sorting bin insert of claim 10, wherein the lightweight material is selected from the group consisting of cardboard, plastic, wood, and composites.
12. (Original) The mail sorting bin insert of claim 9, wherein the insert has two substantially vertical sections.
13. (Original) The mail sorting bin insert of claim 9, wherein the at least one substantially vertical section has a substantially triangular-shaped cross section.
14. (Canceled)
15. (Original) The mail sorting bin insert of claim 9, wherein the insert comprises a single piece of material.
16. (Original) The mail sorting bin insert of claim 15, wherein the insert is folded to create the substantially vertical sections and substantially horizontal sections.

17. (Previously Presented) The mail sorting bin insert of claim 9, wherein the height of each substantially vertical section approximates a height of the mail sorting bin.

18. (Original) The mail sorting bin insert of claim 9, wherein the insert comprises an anti-slip surface.

19. (Previously Presented) A mail sorting bin insert, constructed to be disposed within a mail sorting bin, the insert comprising:

a base defining a substantially planar surface, wherein the base is sized to substantially cover a bottom surface of the mail sorting bin; and

a plurality of substantially vertical supports attached to the base, wherein each substantially vertical support has a slope height and a triangular-shaped cross section sized and configured to support flat mail in a substantially vertical orientation, and wherein each substantially vertical support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin.

20. (Previously Presented) A mail sorting bin insert, constructed to be disposed within a mail sorting bin, the insert comprising:

a flat sheet, wherein the flat sheet includes a plurality of sections and a plurality of predefined fold lines,

wherein two adjacent sections are separated by a predefined fold line,

wherein the predefined fold lines are arranged and configured such that when the flat sheet is folded at the predefined fold lines and disposed within the mail sorting bin, the sheet forms a base and at least one upright support having a height of approximately 11 inches to support flat mail in an upright orientation.

21. (Previously Presented) The mail sorting tub insert according to claim 20, wherein the flat sheet has an upper surface and a lower surface, and wherein at least one predefined fold line on the upper surface permits a first section to rotate with respect to an adjacent second section in one direction, and wherein at least one predefined fold line on the lower surface permits a third section to rotate with respect to an adjacent fourth section in the other direction.

22. (Previously Presented) The mail sorting bin insert of claim 1, wherein the mail sorting bin is approximately 11 inches high.

23. (Previously Presented) The mail sorting bin insert of claim 19, wherein each substantially vertical support of the at least one substantially vertical support has a height of approximately 11 inches.

24. (Previously Presented) The mail sorting bin insert of claim 1, wherein the mail sorting bin is approximately 12 inches wide, 15 inches long, and 11 inches deep.

25. (Previously Presented) The mail sorting bin insert of claim 9, wherein the mail sorting bin is approximately 12 inches wide, 15 inches long, and 11 inches deep.

26. (Previously Presented) The mail sorting bin insert of claim 19, wherein the mail sorting bin is approximately 12 inches wide, 15 inches long, and 11 inches deep.

27. (Previously Presented) The mail sorting bin insert of claim 20, wherein the mail sorting bin is approximately 12 inches wide, 15 inches long, and 11 inches deep.

REMARKS

In response to the Office Action mailed January 18, 2007, Applicants respectfully request reconsideration.

To further the prosecution of this application, each of the rejections presented in the Office Action is responded to below. No amendments have been made. The claims as presented are believed to be in condition for allowance.

I. Rejections Under 35 U.S.C. §103 – Ashbrook in view of Pippin

Claims 1, 2, 4-10 and 12-27 (including independent claims 1, 9, 19 and 20) were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 1,659,509 (“Ashbrook”) in view of U.S. Patent No. 6,715,614 (“Pippin”). These rejections are respectfully traversed.

a. Independent claim 1

The Office Action concedes that Ashbrook does not disclose a mail sorting bin insert “wherein each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin,” as recited in claim 1. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Ashbrook to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin and dimensioning the insert such that it fits closely within letter trays used by the USPS, as taught by Pippin, for the purposes of maintaining sequence order and facilitating delivery and allowing storage and use of the insert with flats tubs or letter trays.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated for the reasons set forth below.

First, the flats tub or letter tray 50 of Pippin is *completely unrelated in structure and function* to the envelope holder of Ashbrook. In particular, the flats tub or letter tray 50 is used by the U.S. Postal Service (e.g., for mail delivery), while the envelope holder of Ashbrook is used by individuals to hold envelopes with a desk drawer (Pippin at col. 6, lines 9-15; Ashbrook at col. 2,

lines 62-66). As a result, there is simply no motivation to dispose the envelope holder of Ashbrook within the flats tub or letter tray 50 of Pippin. Doing so would produce no apparent desirable effect.

In fact, not only is there no suggestion of the desirability of placing the envelope holder of Ashbrook in the flats tub or letter tray 50 of Pippin, but doing so would clearly be *undesirable*. Ashbrook discloses an envelope holder having a principle use “to hold envelopes... within a desk drawer” (col. 2, lines 62-64). Placing the envelope holder of Ashbrook in the flats tub or letter tray 50 of Pippin would prevent the envelope holder from being disposed within a desk drawer, thereby thwarting its principle use. Further, replacing the multi-bag storage device 30 of Pippin with the envelope holder of Ashbrook would also be undesirable. Such a modification would prohibit the intended use of the Pippin device, i.e., “sequence-sorting various types of mail together into individual bags that each represent unique delivery points” (col. 2, lines 22-24). It is well established that the prior art must suggest the desirability of the modification (see e.g., MPEP § 2143.01). Thus, the proposed combination of Ashbrook and Pippin is improper.

Second, there is absolutely no suggestion or motivation to modify the envelope holder of Ashbrook such that each “support” of the envelope holder is “constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin” (i.e., the flats tub or letter tray 50 of Pippin), as suggested in the Office Action. Doing so would again be an undesirable modification of the envelope holder of Ashbrook. The envelope holder is constructed to hold envelopes “in such positions that any of them may be readily be grasped and removed” (col. 1, lines 1-6). If the “supports” of the envelope holder were made significantly greater than the heights of the envelopes, as suggested by the proposed modification, the envelopes could not be readily grasped and removed, making the envelope holder unsatisfactory for its intended purpose. Further, there is no suggestion of the desirability of replacing the multi-bag storage device 30 of Pippin with the envelope holder of Ashbrook. As stated previously, the envelope holder would not be usable for “sequence-sorting various types of mail together into individual bags that each represent unique delivery points,” the objective of the Pippin device, even if there was some motivation to modify the envelope holder in all of the aspects set forth in the Office Action (and Applicants respectfully submit that there is not).

Third, there is no motivation to dimension the envelope holder of Ashbrook such that at least one of the length and the width substantially corresponds to at least one of a length and width of the flats tub or letter tray 50 of Pippin. Indeed, dimensioning the envelope holder of Ashbrook such that at least one of the length and the width substantially corresponds to at least one of a length and width of the flats tub or letter tray 50 of Pippin would be *undesirable*. Dimensioning the envelope holder in this way would make it difficult or impossible to dispose the envelope holder in conventional desk drawers. Further, dimensioning the envelope holder of Ashbrook such that at least one of the length and the width substantially corresponds to at least one of a length and width of the flats tub or letter tray 50 of Pippin would not make the envelope holder usable for sequence-sorting various types of mail together into individual bags (the objective of the Pippin device), or any other obvious purpose.

Fourth, Applicants note that the modifications to the envelope holder of Ashbrook suggested in the Office Action represent a *substantial reconstruction and redesign* of the envelope holder, resulting in a *change of its very purpose*. As set forth in MPEP § 2143.01, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In view of the foregoing, there is no motivation for the combination of Ashbrook and Pippin proposed in connection with the rejection of claim 1. Accordingly, withdrawal of this rejection of claim 1 is respectfully requested.

b. Independent Claim 9

The Office Action concedes that Ashbrook does not disclose a mail sorting bin insert “wherein each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin,” as recited in claim 9. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Ashbrook to include each substantially vertical section has [*sic*] a height of approximately 11 inches when the insert is disposed within the mail sorting bin, as taught by Pippin, for the purpose of storing and using the insert with flats tubs or letter trays.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated for the reasons set forth below.

First, for the reasons discussed in connection with claim 1, there is simply no motivation to dispose the envelope holder of Ashbrook within the flats tub or letter tray 50 of Pippin.

Second, even if a person were for some reason motivated to dispose the envelope holder of Ashbrook within the flats tub or letter tray 50 of Pippin, there would still be no motivation to construct the dividers thereof to have a height of approximately 11 inches. Doing so would again be an undesirable modification of the envelope holder of Ashbrook. As discussed herein, the envelope holder is constructed to hold envelopes "in such positions that any of them may be readily be grasped and removed" (col. 1, lines 1-6). If the "supports" of the envelope holder were made significantly greater than the heights of the envelopes, as suggested by the proposed modification, the envelopes could not be readily grasped and removed, making the envelope holder unsatisfactory for its intended purpose. Further, there is no suggestion of the desirability of replacing the multi-bag storage device 30 of Pippin with the envelope holder of Ashbrook.

In view of the foregoing, there is no motivation for the combination of Ashbrook and Pippin proposed in connection with the rejection of claim 9. Accordingly, withdrawal of this rejection of claim 9 is respectfully requested.

c. Independent Claim 19

There is no motivation for the combination of Ashbrook and Pippin proposed in connection with the rejection of claim 19.

First, for the reasons discussed in connection with claim 1, there is no suggestion or motivation to modify the envelope holder of Ashbrook such that each "support" of the envelope holder is "constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin."

Second, there is no suggestion to modify the envelope holder of Ashbrook such that the base is sized to substantially cover a bottom surface of the flats tub or letter tray 50 of Pippin. Indeed, modifying the envelope holder of Ashbrook such that the base is sized to substantially cover a bottom surface of the flats tub or letter tray 50 of Pippin would be *undesirable*. Modifying the

envelope holder in this way would make it difficult or impossible to dispose the envelope holder in conventional desk drawers, a stated objective of the envelope holder. Further, the modification would not make the envelope holder usable for sequence-sorting various types of mail together into individual bags, a stated objective of the Pippin device, or for any other obvious purpose.

In view of the foregoing, there is no motivation for the combination of Ashbrook and Pippin proposed in connection with the rejection of claim 19. Accordingly, withdrawal of this rejection of claim 19 is respectfully requested.

d. Independent Claim 20

There is no motivation for the combination of Ashbrook and Pippin proposed in connection with the rejection of claim 20. In particular, for reasons similar to those discussed in connection with claim 9, there is no motivation to construct each "support" of the envelope holder of Ashbrook to have a height of approximately 11 inches.

Further, Ashbrook does not teach or suggest "a flat sheet, wherein the flat sheet includes a plurality of sections and a plurality of predefined fold lines," as recited in claim 20. Rather, Ashbrook discloses a sheet metal material including bends that form pockets.

In view of the foregoing, there is no motivation for the combination of Ashbrook and Pippin proposed in connection with the rejection of claim 20, and the combination nevertheless does not disclose each of the features of claim 20. Accordingly, withdrawal of this rejection of claim 20 is respectfully requested.

II. Rejections Under 35 U.S.C. §103 - Lambert in view of Pippin

Claims 1-13 and 15-27 (including independent claims 1, 9, 19 and 20) were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 3,908,821 ("Lambert") in view of U.S. Patent No. 6,715,614 ("Pippin"). These rejections are respectfully traversed.

a. Independent claim 1

The Office Action concedes that Lambert does not disclose a mail sorting bin insert “wherein each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin,” as recited in claim 1. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Lambert to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin, as taught by Pippin, for the purposes of maintaining sequence order and facilitating delivery.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated.

First, the record keeping tray 10 of Lambert is not used for storing or delivering flat mail. Rather, the record keeping tray 10 is used for filing cancelled checks (Abstract). Thus, a person of ordinary skill in the art would not have been motivated to modify Lambert to construct the dividers 13 such that a maximum height of each divider 13 approximates a maximum height of the record keeping tray 10 for the purpose of “facilitating delivery,” as suggested in the Office Action, because the record keeping tray is not used for mail delivery. Moreover, a person of ordinary skill in the art would not have been motivated to modify Lambert in this manner for the purpose of “maintaining sequence order,” as suggested in the Office Action. Making the dividers 13 taller would clearly have no effect on whether the cancelled checks were maintained in an orderly fashion. The dividers 13 are sufficiently tall to support the pockets 14, which hold the cancelled checks, and no apparent benefit would be derived from increasing the height of the dividers 13.

Second, Applicants note that the modifications to the record keeping tray 10 of Lambert suggested in the Office Action represent a *substantial reconstruction and redesign* of the record keeping tray, resulting in a *change of its very purpose*. As set forth in MPEP § 2143.01, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Further, the record keeping tray 10 is not a "mail sorting bin," as recited in claim 1. The tray is used to store cancelled checks and other financial records, and not for sorting mail.

In view of the foregoing, there is no motivation for the combination of Lambert and Pippin proposed in connection with the rejection of claim 1, and the combination nevertheless does not disclose each of the features of claim 1. Accordingly, withdrawal of this rejection of claim 1 is respectfully requested.

b. Independent Claim 9

The Office Action concedes that Lambert does not disclose a mail sorting bin insert "wherein each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin," as recited in claim 9. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Lambert to include each substantially vertical section has [sic] a height of approximately 11 inches when the insert is disposed within the mail sorting bin, as taught by Pippin, for the purpose of storing and using the insert with flats tubs or letter trays.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated. The record keeping tray 10 of Lambert is not used for storing or delivering flat mail. Rather, the record keeping tray 10 is used for filing cancelled checks (Abstract). Thus, there is absolutely nothing in the references or generally known knowledge that would have been motivated a person of ordinary skill in the art to modify Lambert to construct the dividers 13 to have a height of approximately 11 inches "for the purpose of storing and using the insert with flats tubs or letter trays," as suggested in the Office Action. It would simply not be logical to use the record keeping tray 10 with a flats tub or letter tray.

Moreover, modifying the dividers 13 to have a height of approximately 11 inches would serve no apparent beneficial purpose, and would actually be undesirable. The dividers 13 are sufficiently tall to support the pockets 14, which hold the cancelled checks, and no apparent benefit would be derived from increasing their height. Further, constructing each divider 13 to have a height of approximately 11 inches would be an undesirable, because the cover 11 of the record

keeping tray 10 would not be closable if the dividers 13 each had a height of approximately 11 inches.

Further, the record keeping tray 10 is not a “mail sorting bin,” as recited in claim 9. The tray is used to store cancelled checks and other financial records, and not for sorting mail.

In view of the foregoing, there is no motivation for the combination of Lambert and Pippin proposed in connection with the rejection of claim 9, and the combination nevertheless does not disclose each of the features of claim 9. Accordingly, withdrawal of this rejection of claim 1 is respectfully requested.

c. Independent Claim 19

There is no motivation for the combination of Lambert and Pippin proposed in connection with the rejection of claim 19.

First, for the reasons discussed in connection with claim 1, there is no suggestion or motivation to modify the envelope holder of Lambert such that each divider 13 of the record keeping tray 10 is “constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin.”

Second, there is no suggestion to modify the record keeping tray 10 of Lambert such that the base is sized to substantially cover a bottom surface of the flats tub or letter tray 50 of Pippin. Indeed, modifying the record keeping tray 10 of Lambert such that the base is sized to substantially cover a bottom surface of the flats tub or letter tray 50 of Pippin would be *undesirable*. Modifying the envelope holder in this way would make it completely oversized, and therefore unnecessarily unwieldy, for its purpose of storing cancelled checks. Further, the proposed modification would not make the record keeping tray 10 of Lambert usable for sequence-sorting various types of mail together into individual bags, the purpose of the Pippin device.

In view of the foregoing, there is no motivation for the combination of Lambert and Pippin proposed in connection with the rejection of claim 19. Accordingly, withdrawal of this rejection of claim 19 is respectfully requested.

d. Independent Claim 20

There is no motivation for the combination of Lambert and Pippin proposed in connection with the rejection of claim 20.

For reasons similar to those discussed in connection with claim 9, there is no motivation to construct each divider 13 of the record keeping tray 10 of Lambert to have a height of approximately 11 inches.

In view of the foregoing, there is no motivation for the combination of Lambert and Pippin proposed in connection with the rejection of claim 20. Accordingly, withdrawal of this rejection of claim 20 is respectfully requested.

III. Rejections Under 35 U.S.C. §103 - Henig in view of Pippin

Claims 1-13 and 15-27 (including independent claims 1, 9, 19 and 20) were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 3,754,646 ("Henig") in view of U.S. Patent No. 6,715,614 ("Pippin"). These rejections are respectfully traversed.

a. Independent claim 1

The Office Action concedes that Henig does not disclose a mail sorting bin insert "wherein each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin," as recited in claim 1. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Henig to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin, as taught by Pippin, for the purposes of maintaining sequence order and facilitating delivery.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated for the reasons set forth below.

First, the receptacle 1 of Henig is used for an entirely different purpose than the multi-bag storage device 30 of Pippin. In particular, the multi-bag storage device 30 of Pippin is used for "sequence-sorting various types of mail together into individual bags that each represent unique

delivery points” (col. 2, lines 22-24). The receptacle 1 of Henig is used to receive and arrange letters of a single group dropped therein and not to sort mail into separate groups. Each notch 7 of the receptacle 1 is used to hold a *single letter* and the receptacle 1 as a whole is used to hold letters of one group (e.g., an address) (col. 6, lines 1-11, col. 2, lines 23-27 and col. 4, lines 40-51). There is absolutely nothing in the references or generally known knowledge that would have been motivated a person of ordinary skill in the art to modify Henig to construct the notches 7 such that a maximum height of each notch 7 approximates a maximum height of the receptacle. Doing so would serve no apparent beneficial purpose, and would certainly not be a desirable modification. Although the Office Action suggests a motivation of “maintaining sequence order and facilitating delivery,” the letters of Henig are not intended to be in sequence order or separately delivered. Moreover, replacing the individual bags of Pippin with the bottom wall 2 of Henig would undesirably destroy the ability of the Pippin device to sequence-sort various types of mail together into individual bags.

Second, Applicants note that the modifications to the receptacle 1 of Henig suggested in the Office Action represent a *substantial reconstruction and redesign* of the receptacle, resulting in a *change of its very purpose*. As set forth in MPEP § 2143.01, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In view of the foregoing, there is no motivation for the combination of Henig and Pippin proposed in connection with the rejection of claim 1. Accordingly, withdrawal of this rejection of claim 1 is respectfully requested.

b. Independent Claim 9

The Office Action concedes that Henig does not disclose a mail sorting bin insert “wherein each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin,” as recited in claim 9. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Henig to include each substantially vertical

section has [*sic*] a height of approximately 11 inches when the insert is disposed within the mail sorting bin, as taught by Pippin, for the purpose of storing and using the insert with flats tubs or letter trays.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated for the reasons set forth below.

First, the flats tub or letter tray 50 of Pippin is *completely unrelated in structure and function* to the receptacle 1 of Henig. As a result, there is simply no motivation to dispose the receptacle 1 of Henig within the flats tub or letter tray 50 of Pippin. Doing so would produce no apparent desirable effect. In fact, the Pippin device would actually be compromised, because it would no longer be able to serve its intended purpose of sequence-sorting various types of mail together into individual bags.

Second, even if a person were for some reason motivated to dispose the receptacle 1 of Henig within the flats tub or letter tray 50 of Pippin, there would still be no motivation to construct each notch 7 to have a height of approximately 11 inches. Doing so would make it extremely difficult to remove each letter from its corresponding notch (indeed, a special tool would likely be required), and would serve no apparent beneficial purpose. For at least this reason, there is no motivation to construct each notch 7 to have a height of approximately 11 inches based on the teachings of Pippin.

In view of the foregoing, there is no motivation for the combination of Henig and Pippin proposed in connection with the rejection of claim 9. Accordingly, withdrawal of this rejection of claim 9 is respectfully requested.

c. Independent Claim 19

There is no motivation for the combination of Henig and Pippin proposed in connection with the rejection of claim 19.

First, for the reasons discussed in connection with claim 1, there is no suggestion or motivation to modify the envelope holder of Henig such that each notch 7 of the receptacle 1 is “constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin.”

Second, there is no suggestion to modify the receptacle 1 of Henig such that the base is sized to substantially cover a bottom surface of the flats tub or letter tray 50 of Pippin. The proposed modification would compromise the Pippin device by destroying its ability to sequence-sorting various types of mail together into individual bags.

In view of the foregoing, there is no motivation for the combination of Henig and Pippin proposed in connection with the rejection of claim 19. Accordingly, withdrawal of this rejection of claim 19 is respectfully requested.

d. Independent Claim 20

There is no motivation for the combination of Henig and Pippin proposed in connection with the rejection of claim 20.

For reasons similar to those discussed in connection with claim 9, there is no motivation to construct each notch 7 of the receptacle 1 of Henig to have a height of approximately 11 inches.

In view of the foregoing, there is no motivation for the combination of Henig and Pippin proposed in connection with the rejection of claim 20. Accordingly, withdrawal of this rejection of claim 20 is respectfully requested.

IV. Dependent Claims

Claims 2-8, 22 and 24 depend from independent claim 1; claims 10-13, 15-18 and 25 depend from independent claim 9, claims 23 and 26 depend from independent claim 19; and claims 21 and 27 depend from independent claim 20.

Since each of these dependent claims depends from a base claim that is believed to be in condition for allowance, Applicants believe that it is unnecessary at this time to argue the allowability of each of the dependent claims individually. However, Applicants do not necessarily concur with the interpretation of the dependent claims as set forth in the Office Action, nor do Applicants concur that the basis for the rejection of any of the dependent claims is proper. Therefore, Applicants reserve the right to specifically address the patentability of the dependent claims in the future, if deemed necessary.

CONCLUSION

In view of the foregoing, Applicants believe the pending application is in condition for allowance. A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

March 30, 2007

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